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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/835,996	04/16/2001	Dennis G. Ballinger	28110/35915A	6033

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[REDACTED] EXAMINER

TUNG, JOYCE

[REDACTED] ART UNIT [REDACTED] PAPER NUMBER

1637

DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/835,996	BALLINGER ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joyce Tung	1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-20 are subject to restriction and/or election requirement.

#### Disposition of Claims

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) All b) Some \* c) None of:  
1. Certified copies of the priority documents have been received.  
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)                    4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)                    5) Notice of Informal Patent Application (PTO-152)  
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.                    6) Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1 and 3-9, drawn to an isolated polynucleotide having nucleic acid sequence of the SEQ ID numbers as listed in claim 1, classified in class 536, subclass 22.1.
  - II. Claims 2 and 3-9, drawn to an isolated polynucleotide encodes the amino acid sequences as listed in claim 2, classified in class 536, subclass 22.1.
  - III. Claims 10-12, drawn to an isolated polypeptide, classified in class 530, subclass 350.
  - IV. Claim 13, drawn to an antibody, classified in class 530, subclass 388.1.
  - V. Claim 14, drawn to a method of detecting a polynucleotide with a compound, classified in class 435, subclass 6.
  - VI. Claims 15-16, drawn to a method of detecting a polynucleotide via a primer, classified in class 435, subclass 91.2.
  - VII. Claim 17, drawn to a method of detecting a polypeptide with a compound, classified in class 435, subclass 7.1.
  - VIII. Claim 18-19, drawn to a method of identifying a compound that binds to a polypeptide, classified in class 435, subclass 7.1.
  - IX. Claim 20, drawn to a method of producing a polypeptide, classified in class 435, subclass 69.1

2. The inventions are distinct, each from the other because of the following reasons:
  - a. Inventions I-IV and V-IX are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product groups are Groups I-IV which respectively include nucleic acid, protein and antibody. The nucleic acid can be used in nucleic acid purification. The protein can be used in enzymatic reaction. The antibody can be used in immuno-assay.
  - b. Inventions V-IX are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the different inventions are, Group V, claim 14, drawn to a method of detecting a polynucleotide with a compound; Group VI, claims 15-16, drawn to a method of detecting a polynucleotide via a primer; Group VII, claim 17, drawn to a method of a polypeptide with a compound; Group VIII, claim 18-19, drawn to a method of identifying a compound that binds to a polypeptide; Group IX, claim 20, drawn to a method of producing the polypeptide. Based upon the different method steps, and different functions involved in the different invention groups, they are distinct inventions.
  - c. The product groups are distinct in which Groups I and II are drawn to a polynucleotide, Group III is drawn to a polypeptide, and Group IV is drawn to an antibody. Polypeptides and nucleic acids have distinct chemical structures and physical

properties, the former composed of amino acids and the latter composed of nucleotides. Further, they have distinct utilities, such as use of nucleic acids in hybridization and use of proteins for enzymatic function. The antibody is protein composed of amino acid in that it has its special biochemical structures and special utilities, such as immuno-assay or protein purification. Therefore, the above inventions are novel and unobvious over each other.

d. Among the groups I and II, although both of them are drawn to polynucleotide, Group I is drawn to the polynucleotide having the different nucleotide sequence from the polynucleotide of Group II, Therefore, the above inventions are novel and unobvious over each other.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. These claims are generic to a plurality of disclosed patentably distinct restriction groups comprising different SEQ ID NOs. Applicant is required under 35 U.S.C. 121 to elect no more than 1 disclosed nucleic acids even though this requirement is traversed.

Should applicant traverse on the ground that some or all of the different nucleic acids are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the nucleic acids to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior

art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joyce Tung whose telephone number is 703 (305) 7112. The examiner can normally be reached on Monday - Friday, 8:30-5:00.

7. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on 703 308 1119. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 (308) 0196.

Joyce Tung  
September 21, 2003



**ETHAN WHISENANT**  
**PRIMARY EXAMINER**

**ETHAN WHISENANT**  
**PRIMARY EXAMINER**